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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Nancy J. Flint Hunton & Williams 1111 Brickell Avenue Miami, FL 33131				
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EXAMINER				
CHAMPAGNE, DONALD				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/921,060

Applicant(s)

STEINBERG, MARTY

Examiner

Donald L. Champagne

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-18 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-18 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-144a or PTO-804a)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Interval Patent Application (PTO-152)
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5-18 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US006061660A).
3. Eggleston et al. teaches (independent claims 1, 16, 22 and 23) a method and system for managing purchasing incentives offered to consumers through their existing memberships in loyalty programs, the method comprising:

receiving information regarding existing incentive/loyalty programs available to a consumer who revisits a host incentive program system (col. 15 line 60 to col. 16 line 13, col. 12 line 64 to col. 13 line 3 and col. 13 lines 20-21), which reads on receiving information regarding each consumer's existing memberships in one or more loyalty programs, the membership information comprising the name of the *sponsor/offering* company or organization for each loyalty program in which the consumer has membership (col. 16 lines 30-33 and col. 41 line 42) and identification information sufficient to identify each existing membership (*consumer's name* and *password*, col. 16 lines 3-13);

storing the received membership information in a searchable database (*consumer database 200* and *sponsor database 202*, col. 12 lines 15-17);

receiving a query from one of the consumers comprising a request to identify purchasing incentives for a specific product or service (*a sponsoring company's products or services*) available through the one or more loyalty programs in which the consumer has membership (col. 12 lines 49-53, col. 16 lines 30-32, and col. 1 lines 30-36);

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verifying that the consumer's existing membership in the one or more loyalty programs is valid by comparing the identification information received from the consumer to enrollment information received from the one or more loyalty programs (col. 25 lines 15-40);

processing the query to determine if any incentives are available for the specific product or service (col. 16 lines 33-41); and

transmitting to the consumer information identifying purchasing incentives available through the one or more loyalty programs in which the consumer is a member for the specific product or service (col. 16 lines 58-65).

4. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

"wherein each consumer previously enrolled in the one or more loyalty programs prior to the information for that respective consumer being received and each consumer's previous enrollment is distinct from receiving the membership information for that respective consumer,"

In the sense used in the patent law (35 USC 101), this material is not functional because it is neither "tied to a particular apparatus" nor "operates to change materials to 'a different state or thing'" (*IN RE COMISKEY*, CAFC 2006-1286, September 2007).

5. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
6. The instant application contains no such clear definition for the term "membership" or "member". In the instant case, the examiner is required to give the term "member" its

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broadest reasonable interpretation, which the examiner judges to be “one of the individuals composing a group” (Merriam-Webster’s Collegiate® Dictionary, 10th ed.). In Eggleston et al., each incentive program registered by the sponsors (col. 12 line 67) in the *host incentive program system* reads on a group in which the consumer is a member when the consumer registers with the *host incentive program system* (col. 12 lines 26-27).

7. Eggleston et al. does not teach that information regarding the consumer’s existing memberships in one or more loyalty programs is received from a plurality of consumers. Because it would be advantageous to have as many participating offering companies/sponsors as possible in the *sponsor database 202*, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that consumers be invited to recommend sponsors to the *sponsor database 202*, which would read on receiving from a plurality of consumers information regarding the consumer’s existing memberships in one or more loyalty programs.
8. The U.S. Supreme Court has recently ruled that it is obvious to combine prior art elements according to known methods to yield predictable results (*KSR INT’L CO. VS TELEFLEX INC.* 550 U.S. ____ (2007)). It is well known that consumers recommend loyalty programs to their friends. It would be obvious for those same consumers to recommend the loyalty programs for inclusion into a database of loyalty programs from which they themselves could benefit. The likely result would be greater consumer participation in the *host incentive program system*. Although this result is not certain, it is likely enough to justify a trial invitation to consumers for loyalty program sponsor recommendations. The Supreme Court also ruled in the *KSR* decision that it is obvious to try a new approach when there is a reasonable expectation of positive results.
9. Eggleston et al. also teaches at the citations given above claims 15 and 21.
10. Eggleston et al. also teaches: claims 2, 5, 6, 8, 17 and 18 (col. 14 lines 7-25, where for claims 5 and 18 querying *sponsor database 202* reads on transmitting the query to a plurality of offering companies and organizations); claims 9-11 (col. 18 lines 46-57); claim 14 (col. 15 lines 8-12); claim 24 (col. 6 lines 35-38); and claim 25 (col. 12 lines 38-48). Claim 26 comprises only non-functional descriptive material and was not given patentable weight (para. 4 above). Claim 27 is taught inherently: since the reference teaches means for

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providing information from a plurality of offering companies (col. 6 lines 35-38), said means must be configured to *receive* said information.

11. Eggleston et al. does not teach (claim 7) storing the query in a searchable database. Because the queries would be useful marketing information for the offering companies/sponsors, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that the query be stored in searchable consumer database **200**.
12. Eggleston et al. does not teach (claim 12) that at least some of the marketing information is transmitted anonymously. Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to guard the privacy of consumers by anonymous dissemination of consumer data. Because it is obvious to follow common practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that at least some of the marketing information is transmitted anonymously.
13. Eggleston et al. does not teach (claim 13) offering compensation to the querying consumer if no incentive is available in response to the query. Because it would enhance customer service, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that compensation be offered if no incentive is available in response to the query.

Response to Arguments

14. Applicant's arguments filed with an amendment on 29 February 2008 have been fully considered but they are not persuasive. The arguments are addressed by the revised rejection presented herein.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of

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the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
18. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
20. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
21. Applicant may have after final arguments considered and amendments entered by filing an RCE.

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22. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

26 May 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688